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EXAMINER
RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
2175	16

DATE MAILED: 08/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/941,681	MAYAUD, CHRISTIAN	
	Examiner	Art Unit	
	Sam Rimell	2175	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 70-91 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 70-91 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 70-86 and 88-91 are rejected under 35 U.S.C. 102(e) as being anticipated by Schrier et al. ('599).

Claim 70: FIG. 11 of Schrier et al. discloses a system including a computer readable medium which is used to create an electronic prescription that is ultimately printed out and converted into a paper prescription. The electronic prescription includes a patient identifier (patient name), prescribed drug and drug quantifier("gentamicin 130 mg intravenously every 8 hours" and "Tylenol 250 mg" and "Penicillin 250 mg IV every four hours"). The patient includes a patient identifier data capture device (data capture field for patient name) and well as a prescribed drug and drug quantifier capture device (data capture fields for prescribed drugs and drug quantities in FIG. 11). The patient condition data capture device is the data capture field (312) permitting entry of the patient condition "pain", which indicates a current condition of the patient. When the electronic prescription system is used, it may call upon a library of prescription drugs (col. 13, line 60 through col. 14, line 5). A printer prints the completed prescription (col. 14, line 65 through col. 15, line 1).

Claim 71: FIG. 10 illustrates personal preference drug selections. In particular, the system tracks preferences for type of drug therapy and physical form of the drug. The system

tracks these selections (saves them to memory) and updates changes whenever changes are made to the selections.

Claim 72: FIG. 10 illustrates that for each condition illustrated, such as asthma, there exists a selection list which permits selection of therapy and dosing form. The condition itself may also be selected (col. 8, lines 42-46) by the user.

Claim 73: FIG. 11, section (312) illustrates the patient's history of previously prescribed drugs (For example, Tylenol) and treatment objectives (For example, Tylenol for treatment of pain).

Claim 74: Col. 8, lines 42-46 describes the input of patient conditions into the system. The patient conditions which are input become the patient condition list. This information will become part of the patient's history in section (312).

Claim 75: The electronic prescription system is a source oriented data retrieval subsystem. This subsystem may be connected to data retrieval network, such as a hospital information system or hospital database (col. 6, lines 27-32).

Claim 76: FIG. 4 illustrates a screen providing information on drug interactions. By pressing the "allergies" button, analogous information may be obtained on drug allergies.

Claim 77: The patient prescription history (312 in FIG. 11) is a current, contemporaneous record. The method by which the record is assembled is considered an intended usage of the system, and carries no patentable weight.

Claim 78: Any of the screens illustrated in Schrier et al. are user interfaces. The method steps by which the patient history record are obtained are considered an intended usage of the system, and carry no patentable weight.

Claim 79: FIG. 3 illustrates a list of drugs (232) which are classified into groups. Each group is related to a patient condition. For example, antifungals would be used for treating a fungus condition. Antidepressants would be used for treating depression. The user can select one these groups associated with patient condition and determine prescribable drugs for that condition.

Claim 80: No patentable weight is attributed to the patient's ownership of a drugs benefits plan or association with a drug benefit provider, since these features are not part of a prescription, or a physical system for creating a system. Schrier et al. does disclose a formulary (col. 13, lines 63-65) which is a subset of recommended drugs and dosages which are recommended (col. 14, lines 6-10) and displayed to the user. The "formulary preference" is set of drugs reccomended by the system (col. 14, lines 6-10) and is presented as reccomendation during the completion of the prescription. If the formulary recommendations are not used, the list of drugs recommended by the physician become a nonformulary drug list.

Claim 81: Col. 6, lines 27-32 describe the electronic prescription system as gaining access to remote data systems. No patentable weight is attributed to who actually provides the data, such as a benefits management company since this has no bearing on the physical structures of the electronic prescription system.

Claim 82: The information provided from the formulary relates to dosage recommendations for drugs. As best as can be understood, this reads as information regarding prescribability.

Claim 83: Col. 13, lines 38-52 describe the recordation of previous physician orders. Each previous physician order includes time and date, and the physician making the order (col.

13, lines 50-52). Each of these orders is a previous user access to the system. The record of these orders constitutes a log.

Claim 84: FIGS 19-22 illustrate a decision making routine that considers dosing, amount and time of termination of therapy in deciding which course of therapy is best for the patient. The recommended time for termination of therapy reads as the "expiration drug quantifier".

Claim 85: Col. 6, lines 27-32 describe the connection of the Schrier et al. system to remote hospital information systems. Data access control is established by the usage of passwords, which are the data access control specification means.

Claim 86: FIG. 3 is a screen providing a list of drugs (232) and a set of categories (234) which are associated with patient conditions. For example, "antifungals" would be associated with a fungus condition. There are at least five drugs and five categories.

Claim 88-89: Col.14, line 65 through col. 15, line 2 describe the output of a prescription from the system to a pharmacy. The pharmacy is remote storage.

Claim 90: The prescription includes dosage schedule (FIG. 11—gentamicin 130mg intravenously every 8 hours).

Claim 91: See remarks for claim 80.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schrier et al. ('599).

Claim 87: FIG. 3 is a screen providing a list of drugs (232). Although the reference does not state how many drugs are on the list, forming the list to include 50% or more of the known FDA approved drugs would have been obvious to one of ordinary skill in the art as a choice of advantageous design. The skilled artisan would readily recognize the desirability of having the list as complete as possible.

Remarks

Applicant's amendments have overcome the previously applied rejections under 35 USC 112.

Applicant's arguments in reference to Schrier et al. have been considered.

With respect to claim 70, applicant argues that Schrier et al. does not disclose a data capture device for capturing patient condition data. Examiner maintains that the box 312 is such a data capture device, and captures data that pertains to a particular patient condition (the presence of pain). This interface does in fact meet all of the limitations set forth with respect to this particular device.

With respect to claim 71, applicant argues that Schrier et al. does not disclose a tracking of preference data. Examiner maintains that FIG. 10 illustrates the entry of preference data, such as the preferred implementation of prophylaxis therapy as a technique for treating asthma, where the preferred form of the prophylaxis drug is nebulized. This data, once entered, is saved to memory. The action of saving to memory is a form of tracking., and Examiner does not agree that there exists any distinction between saving information to memory and tracking information.

With respect to the rejection under 35 USC 103, applicant argues that there is no motivation for the modification provided. Examiner maintains that motivation is in fact provided, namely, the desirability of having a complete data listing, which would be immediately and readily recognized by the person of ordinary skill in the art.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.

Sam Rimell
Primary Examiner
Art Unit 2175